

## REMARKS

### Allowable subject matter

The Examiner's indication of allowable subject matter for claims 18-33 is gratefully acknowledged.

### Claim Status

Claims 1-33, 36, 37 and 39 are pending in the application.

By this amendment, claims 1 to 3 and 17 were cancelled and claims 4 to 14, 18 to 33, 36 and 37 were amended.

Claim 4 is based on former claim 4 which has been further limited with respect to  $X_1$ ,  $X_2$ ,  $R_1$  and  $R_2$ , and wherein the terms "prodrugs" and "metabolites" have been deleted.

Claims 5-7 are based on former claims 5-7 respectively, wherein the terms "prodrugs" and "metabolites" have been deleted, and the term "lactosyl" has been added to the meaning of  $X_3$  in said claim to cover the exemplified compound UBS4209 wherein  $X_3$  is lactosyl.

Claim 8 is based on former claim 8, wherein the terms "prodrugs" and "metabolites" have been deleted, and the term "lactosyl" has been added to the meaning of  $X_7$  in said claim to cover the exemplified compound UBS3976 wherein  $X_7$  is lactosyl.

Claim 9 is based on former claim 9, wherein the terms "prodrugs" and "metabolites" have been deleted, and the term "lactosyl" has been added to the meaning of  $X_3$  in said claim to cover the exemplified compound UBS4209 wherein  $X_3$  is lactosyl, and the list of groups for  $X_3$  and  $X_3$  was limited to its meanings in the first part of claim 9.

Claims 10 and 12 are based on former claims 10 and 12 respectively, wherein the terms "prodrugs" and "metabolites" have been deleted, and the term "lactosyl" has been added to the meaning of  $X_3$  and  $X_7$  in said claim to cover the exemplified compound UBS4209 wherein  $X_3$  and  $X_7$  is lactosyl, and the list of groups for  $X_3$  and  $X_3$  was limited to its meanings in the first part of claim 10 and 12 respectively.

Claim 11 is based on former claim 11, wherein the terms "prodrugs" and "metabolites" have been deleted, and the term "lactosyl" has been added to the meaning of  $X_3$  and  $X_7$  in said claim to cover the exemplified compound UBS4209 wherein  $X_3$  and  $X_7$  is lactosyl.

Claim 13 is based on former claim 13, wherein the terms “prodrugs” and “metabolites” have been deleted.

Claim 14 is based on former claim 14, wherein the term “comprising” has been deleted in reply to the Examiner’s objection. The dependencies in said claim were further amended.

Claims 18-33, 36 and 37 are based on former claims 18-33, 36 and 37 respectively, the dependencies of which were amended.

Applicants respectfully submit that the amendments to the claims do not introduce any new subject matter into the application.

**Claims rejection under 35 USC § 112 first paragraph**

Claims 1-17, 36, 37 and 39 are rejected under 35 USC § 112 first paragraph for allegedly lacking enablement. Applicant respectfully disagrees. Nevertheless in order to advance the case to allowance, claims 1 to 3 have been cancelled and the subject matter of claims 4 to 13 have been limited.

In view of Applicants’ amendments, reconsideration and withdrawal of the rejection is respectfully requested.

**Claims rejection under 35 USC § 112 second paragraph**

Claims 1-17, 36, 37 and 39 are rejected under 35 USC § 112 second paragraph for allegedly being indefinite. The claims have been amended to address this rejection as discussed above. Reconsideration and withdrawal of the rejection is respectfully requested.

**Claims rejection on the ground of nonstatutory obviousness-type double patenting.**

Claim 17 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/538,993. Claim 17 is cancelled thereby obviating the rejection.

**No Disclaimers or Disavowals**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this

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application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

### CONCLUSION

In view of Applicants' amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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